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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,120	12/26/2001	Shuichi Matsumoto	252-000007	3429

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/036,120

Applicant(s)

MATSUMOTO ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9,11-14,16-19,21-24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-14, 16-19, 21-24, and 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-4, 6-9, 11-14, 16-19, 21-24, and 26-34 have been examined.

Response to Amendments/Arguments

2. Applicant has amended the claims to further describe content restriction information (i.e. "said music parts and phrases being time-synchronized together for simultaneous, synchronous playback"). However, claims 1, 13 and 28 are directed to an apparatus, and as music parts and phrases are not functionally related to the memory on which they are stored, limitations directed to further describing the parts and phrases do not distinguish the claims from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). Regarding claims 8, 18 and 23, as the phrase "said music parts and phrases being time-synchronized together for simultaneous, synchronous playback" is not a method step and therefore cannot be relied upon to distinguish the claims from the prior art.

Regarding the term "operable", although there is nothing inherently wrong in defining something by what it does (*In re Hallman* 210 USPQ 609) and features of an apparatus may be recited either structurally or functionally, claims

directed to an apparatus must be distinguished in terms of structure rather than function (MPEP 2114; *In re Schreiber* 44 USPQ2d 1429 (1997)). The term “operable” is synonymous with “practicable”, which is defined as “possible to practice or perform” (Webster's Ninth New Collegiate Dictionary). Further, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP, 2106, section II, C). Therefore, as it is *possible* for the server of Ginter et al. to set user restriction information for all contents of the contents file, such as the server/computer of the original content creator (column 308, lines 30-35), the prior art continues to read on Applicant's claimed apparatus and method.

Ginter et al. teach combining content from a plurality of endusers into a single piece of content (column/line 31/64-33/35; 285/65-287/45; column 321, lines 5-28 and 42-63; column 141, lines 5-25; column/line 322/48-323/8; column/line 325/58-326/26; column 330, lines 8-12). Therefore, to one of ordinary skill, Ginter et al. at least suggest multiple users collaborating to produce a piece of music, such as a song, where each user contributes a portion of the song (e.g. melody, chorus, trumpet section, guitar solo) and controls how her/his portion is used (column 9, lines 18-24; column 166, lines 20-31). Note, to one of ordinary skill, a song is necessarily the result of a melody, rhythm section, and chorus, etc., hence a songs parts are played back simultaneously and synchronously.

Stoneking et al. teach a system for restricting use of content (abstract). More specifically, Stoneking et al. teach controlling the characteristics and behavior of content such as style, speech, actions and moralities (column 5, lines 46-64). Stoneking et al. is directed to content such as animated characters. However, when combined with Ginter, the combined prior art suggests to one of ordinary skill a method and system for exerting digital rights over content characteristics such as the tempo of a song or the brightness of an image ('390, column 5, lines 46-64; column 141, lines 5-25). Therefore, the prior art of Ginter et al. and Stoneking et al. reads on Applicants claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4, 6-9, 11-14, 16-19, 21-24, and 26-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 8, 13, 18, 23 and 28 have been amended to recite "said music parts and phrases being time-synchronized together for simultaneous, synchronous playback". Claims 1, 8, 13, 18, 23 and 28 also recite content being

subdivided into parts "*selected from the group consisting of music parts and phrases*" (emphasis added). Hence, Applicants music program can be divided into music parts or phrases but not necessarily both, therefore, when in the alternative "or" case (i.e. either music parts or phrases) the time synching of music parts and phrases time is not possible.

Claims 2-4, 6, 7, 9, 11, 12, 14, 16, 17, 19, 21, 22, 24, 26, 27 and 29-34 are also rejected as each depends from either claim 1, 8, 13, 18, 23 or 28.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-9, 11-14, 16-19, 21-24, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U.S. Patent No. 5,892,900.

As per claims 1-4, 6-9, 11-14, 16-19, 21-24, and 26-28, Ginter et al. teach a contents providing service system comprising:

- contents file that includes encrypted (partial) content (e.g. music) and use restriction information (figure 19; column 135, lines 20-34; column 141, lines 5-25), use allow range and use prohibit range (column 137, lines 50-64; column 155, lines 38-51; column 157, lines 1-13; column 166, lines 25-32; column 294, lines 17-51) and provisional use prohibit range that provides for conditional use of content after fee payment (figure 72D; column 36, lines 22-38; column 140, lines 25-38; column 160, lines 15-35)
- server supply unit for supplying content to client (column 18, lines 55-63; column 134, lines 39-58; column 315, lines 25-42)
- client apparatus comprising decoding unit and a restricting unit for (figure 7; column 60, lines 7-44; column 62, lines 32-50)
- client apparatus for transmitting to the server apparatus for requesting use of content (figure 72D) and for implementing user restriction (figure 7; column 60, lines 7-44; column 62, lines 32-50)
- server apparatus includes a user approve unit for transmitting a user approval to the client apparatus in response to fee paid and allows client to use content based on restriction information (figure 72D)

Ginter et al. teach combining content from a plurality of endusers into a single piece of content (column/line 31/64-33/35; 285/65-287/45; column 321, lines 5-28

and 42-63; column 141, lines 5-25; column/line 322/48-323/8; column/line 325/58-326/26; column 330, lines 8-12). Therefore, to one of ordinary skill, Ginter et al. at least suggest multiple users collaborating to produce a piece of music, such as a song, where each user contributes a portion of the song (e.g. melody, chorus, trumpet section, guitar solo) and controls how her/his portion is used (column 9, lines 18-24; column 166, lines 20-31). Note, to one of ordinary skill, a song is necessarily the result of a melody, rhythm section, and chorus, etc., hence a songs parts are played back simultaneously and synchronously (i.e. time-synched). Ginter et al. also teach content distribution system where content usage is determined by rights or restriction (column 9, lines 20-24).

7. Claims 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U.S. Patent No. 5,892,900 in view of Stoneking et al., U.S. Patent No. 5,982,390.

As per claims 29-34, Ginter et al. disclose a method and system for allowing content creators to create, distribute and control the use of content (abstract). Ginter et al. do not specifically recite restricting use by tempo or tone. On the other hand, Ginter et al. at least suggest multiple users collaborating to produce a piece of music, such as a song, where each user contributes a portion of the song (e.g. melody, chorus, trumpet section, guitar solo) and controls how her/his portion is used (column 9, lines 18-24; column 166, lines 20-31).

Stoneking et al. teach a system for restricting use of content (abstract). More specifically, Stoneking et al. teach controlling the characteristics and behavior of content such as style, speech, actions and moralities (column 5, lines 46-64). Stoneking et al. is directed to content such as animated characters. However, when combined with Ginter, the combined prior art suggests to one of ordinary skill a method and system for exerting digital rights over content characteristics such as the tempo of a song or the brightness of an image ('390, column 5, lines 46-64; column 141, lines 5-25).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

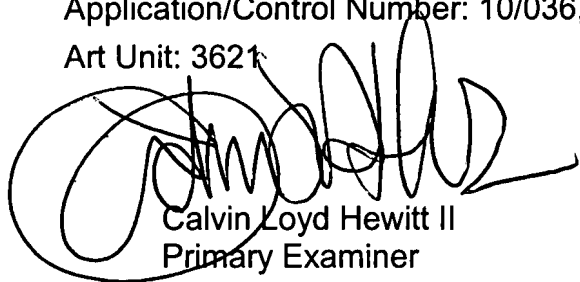
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Calvin Hewitt II", is written over the printed name and title.

Calvin Loyd Hewitt II
Primary Examiner

December 19, 2006